



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,049	12/20/2001	Victor Tan Cher 'Khng	00-1117	5617

22823 7590 10/11/2006

STEPHEN A GRATTON
THE LAW OFFICE OF STEVE GRATTON
2764 SOUTH BRAUN WAY
LAKEWOOD, CO 80228

EXAMINER

GRAYBILL, DAVID E

ART UNIT	PAPER NUMBER
----------	--------------

2822

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

10-023049

EXAMINER

ART UNIT	PAPER
----------	-------

20061001

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

David E Graybill
Primary Examiner
Art Unit: 2822

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The following is a quotation of MPEP 2111.01 [R-3] Plain Meaning:
I. THE WORDS OF A CLAIM MUST BE GIVEN THEIR "PLAIN MEANING" UNLESS THEY ARE DEFINED IN THE SPECIFICATION

While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. In re American Academy of Science Tech Center, *367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004)* (The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation.). This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, *893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)* (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, *358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004)* (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say. Thus, "heating the resulting batter-coated dough to a temperature in the range of about 400oF to 850oF" required heating the dough, rather than the air inside an oven, to the specified temperature.). One must bear in mind that, especially in nonchemical cases, the words in a claim are generally not limited in their meaning by what is shown or disclosed in the specification. See, e.g., *Liebel-Flarsheim Co. v. Medrad Inc.*, *358 F.3d 898, 906, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004)* (discussing recent cases wherein the court expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment). It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. In re Vogel, *422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970)*. See also *Superguide Corp. v. DirecTV Enterprises, Inc.*, *358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004)* ("Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment."); *E-Pass Techs., Inc. v. 3Com Corp.*, *343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003)* ("Interpretation of descriptive statements in a patent's written description is a difficult task, as an inherent tension exists as to whether a statement is a clear lexicographic definition or a description of a preferred embodiment. The problem is to interpret claims in view of the specification' without unnecessarily importing limitations from the specification into the claims."); *Altiris Inc. v. Symantec Corp.*, *318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869-70 (Fed. Cir. 2003)* (Although the specification discussed only a single embodiment, the court held that it was improper to read a specific order of steps into method claims where, as a matter of logic or grammar, the language of the method claims did not impose a specific order on the performance of the method steps, and the specification did not directly or implicitly require a particular order). See also paragraph III., below. There

Art Unit: 2822

is one exception, and that is when an element is claimed using language falling under the scope of 35 U.S.C. 112, 6th paragraph (often broadly referred to as means or step plus function language). In that case, the specification must be consulted to determine the structure, material, or acts corresponding to the function recited in the claim. In re Donaldson, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) (see MPEP § 2181- § 2186). In In re Zletz, supra, the examiner and the Board had interpreted claims reading "normally solid polypropylene" and "normally solid polypropylene having a crystalline polypropylene content" as being limited to "normally solid linear high homopolymers of propylene which have a crystalline polypropylene content." The court ruled that limitations, not present in the claims, were improperly imported from the specification. See also In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) ("Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their broadest reasonable interpretation." 710 F.2d at 802, 218 USPQ at 292 (quoting In re Okuzawa, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)) (emphasis in original). The court looked to the specification to construe "essentially free of alkali metal" as including unavoidable levels of impurities but no more.). Compare In re Weiss, 989 F.2d 1202, 26 USPQ2d 1885 (Fed. Cir. 1993) (unpublished decision - cannot be cited as precedent) (The claim related to an athletic shoe with cleats that "break away at a preselected level of force" and thus prevent injury to the wearer. The examiner rejected the claims over prior art teaching athletic shoes with cleats not intended to break off and rationalized that the cleats would break away given a high enough force. The court reversed the rejection stating that when interpreting a claim term which is ambiguous, such as "a preselected level of force", we must look to the specification for the meaning ascribed to that term by the inventor." The specification had defined "preselected level of force" as that level of force at which the breaking away will prevent injury to the wearer during athletic exertion. It should be noted that the limitation was part of a means plus function element.)

In response to this requirement, please indicate where the specification provides a **clear definition** for the claim language "a height less than that of a solder ball external contact having a diameter of from 0.3 mm to 0.762 mm," and, "the spacing of solder ball external contacts having a diameter of from 0.3 mm to 0.762 mm," and, "that of solder ball external contacts having a diameter of from 0.3 mm to 0.762 mm," and, "that of the solder ball external contacts." If there is no clear definition in the specification for the language, please provide a clear definition for the language and provide evidence supporting this definition. Mere examples of a height less than that of a solder ball external contact having a diameter of

from 0.3 mm to 0.762 mm and the spacing of solder ball external contacts having a diameter of from 0.3 mm to 0.762 mm and that of solder ball external contacts having a diameter of from 0.3 mm to 0.762 mm and that of the solder ball external contacts will not satisfy this requirement.

In response to this requirement, please provide answers to each of the following interrogatories eliciting factual information:

1) What is the magnitude of a height less than that of a solder ball external contact having a diameter of from 0.3 mm to 0.762 mm?

2) What is the magnitude of the spacing of solder ball external contacts having a diameter of from 0.3 mm to 0.762 mm?

Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

For information on the status of this application applicant should check PAIR:

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 2822

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alternatively, applicant may contact the File Information Unit at (703) 308-2733. Telephone status inquiries should not be directed to the examiner. See MPEP 1730VIC, MPEP 203.08 and MPEP 102.

Any other telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (571) 272-1930. Regular office hours:

Monday through Friday, 8:30 a.m. to 6:00 p.m.

The fax phone number for group 2800 is (571) 273-8300.



David E. Graybill
Primary Examiner
Art Unit 2822

D.G.

1-Oct-06